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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,825	05/23/2001	Robert E. Krall	PROV1110-3	9432

28213 7590 03/26/2003

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EXAMINER

CHOI, FRANK I

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 03/26/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/863,825

**Applicant(s)**

KRALL ET AL.

**Examiner**

Frank I Choi

**Art Unit**

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 1616

## DETAILED ACTION

### *Terminal Disclaimer*

The terminal disclaimers filed on 12/16/2002 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Patent No. 6,037,366 and any patent granted on Application Nos. 09/823,775, 09/241,368, 09/497,075 and 09/577,115 have been reviewed and are accepted. The terminal disclaimers have been recorded.

### *Claim Rejections - 35 USC § 102/103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans et al. (US Pat. 5,695,480) in view of Tseng et al., Woodward, Clark et al. (US Pat. 5,981,621), Hoffman (US Pat. 4,359,454), Krall (US Pat. 4,713,235), Almen et al., EP 0 747 069 and Leung et al. (US Pat. 5,328,687) for the reasons of record set forth in the prior Office Action in further view of McIntire et al. (US Pat. 3,654,239) and Berger et al. (US Pat. 5,998,472) and the further reasons below.

Evans et al. (US Pat. 5,695,480) in view of Tseng et al., Woodward, Clark et al. (US Pat. 5,981,621), Hoffman (US Pat. 4,359,454), Krall (US Pat. 4,713,235), Almen et al., EP 0 747 069 and Leung et al. (US Pat. 5,328,687) were discussed in the prior Office Action and the same are incorporated herein.

Art Unit: 1616

McIntire et al. teach that polymers of alkyl cyanoacrylates may be added to monomer alkyl cyanoacrylates to prevent undue escape of the adhesive from any given area and to allow sufficient time for the monomeric material to polymerize (Column 1, lines 64-70, Column 2, lines 22-55).

Berger et al. teach the use of two different monomers which provides enhanced flexibility of the polymer (Column 7).

The difference between the prior art and the claimed invention is that the prior art does not expressly disclose the use of mixtures of alkyl cyanoacrylates with a second component which includes an oligomer of alkyl cyanoacrylate, a plasticizer and opacificant agent. However, the same is amply suggested by the prior art as compositions and methods comprising alkyl cyanoacrylates, plasticizers and opacificant agents and methods for their use and the addition of polymers of alkyl cyanoacrylates as thickeners and mixtures of monomers of alkyl cyanoacrylates are known in the art. As such, it would have been well within the skill of and one of ordinary skill in the art would have been motivated to use a two component composition of monomeric alkyl cyanocrylates and polymeric alkyl cyanocrylates with the expectation that the combination would prevent undue escape of the adhesive and allow sufficient time for the monomeric material to polymerize and that the use of two different monomers of alkyl cyanocrylates would result in a more flexible polymer.

Examiner has duly considered Applicant's arguments but deems them unpersuasive in light of the above.

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the references.

Art Unit: 1616

Note that the above is not intended to apply to subject matter patented in U.S. Patents Nos. 6,037,366 (Krall et al.) and 4,713,235 (Krall) as the prior art does not provide the requisite disclosure, suggestion, or motivation to utilize 2-hexyl cyanoacrylate in combination with all of the other specific compounds as set forth in claims 1-5 of the former and the combination of the ester of 2-cyanoacrylic acid in combination with triiodophenol, iodoform or tetraiodoethylene having the claimed amounts of iodine as set forth in Claims 1-15 of the latter.

***Conclusion***


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (703) 308-0067. Examiner maintains a flexible schedule. However, Examiner may generally be reached Monday-Friday, 8:00 am – 5:30 pm (EST), except the first Friday of the each biweek which is Examiner's normally scheduled day off.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. José Dees, can be reached on (703) 308-4628. Additionally, Technology Center 1600's Receptionist and Customer Service can be reached at (703) 308-1235 and (703) 308-0198, respectively.

FIC

March 24, 2003

  
JOHN PAK  
PRIMARY EXAMINER  
GROUP 1600

